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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/018,104 02/03/98 HOBART

J PHAN-00100

EXAMINER

QM12/0326

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PALO ALTO CA 94306

SHAY, D  
ART UNIT

PAPER NUMBER

3739  
DATE MAILED:

03/26/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks



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DATE MAILED:

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on October 2, 2000 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), \_\_\_\_\_ days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- |   |  |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892.        | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948.                   |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.  | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____  |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-40 are pending in the application.  
Of the above, claims 15, 16, + 25-40 are withdrawn from consideration.
2. ☐ Claims \_\_\_\_\_ have been cancelled.
3. ☐ Claims \_\_\_\_\_ are allowed.
4. ☒ Claims 1-14 + 17-24 are rejected.
5. ☐ Claims \_\_\_\_\_ are objected to.
6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.
7. ☐ This application has been filed with Informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_ Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on \_\_\_\_\_ has been ☐ approved. ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received  
☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_
13. ☐ Since this application appears to be in condition for allowance except for formal matters; prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

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The amendment filed October 10, 2000 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the concept of the use of a single wavelength.

Applicant is required to cancel the new matter in the reply to this Office action.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4 and 16-24 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The originally filed disclosure is silent on the use of a single wavelength.

The rejections set forth in the previous office action are hereby repeated.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-3, 6-8, 11-14, and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sklar et al in combination with Dew ('969), Belkin et al and Anderson et al..

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Sklar et al teach a laser system including multiple lasers with a graphical interface and teach that it can be used for any type of surgery with any type of laser and that the depth of the laser action can be input and displayed. Dew ('969) teaches the use of a carbon dioxide laser operating 10.6 microns as a cutting laser in a laser system comprised of multiple lasers and teaches that the power of a pulse determines the amount of heat deposited in the tissue. Belkin et al teach that carbon dioxide lasers operating at 10.6 microns can be used to heat, rather than cut tissue. Anderson et al teach the way parameters such as absorptivity, spot size, and pulse width interrelate to control the amount of energy absorbed by tissue. It would have been obvious to the artisan of ordinary skill to use a carbon dioxide laser as taught by Dew (969) in the graphical user interface of Sklar et al, since this is to be used with any laser, as taught by Sklar et al, to also configure the laser to coagulate as taught by Belkin et al, since this would render the device more versatile, at no extra cost, and is within the scope of one having ordinary skill in the art as shown by Anderson et al and employ an articulated arm with refocussing optics, since these are notorious in the art for transporting infrared radiation such as that from Carbon dioxide lasers, official notice of which has already been taken, thus producing a device such as claimed.

Claims 4, 5, 9, 10, and 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sklar et al in combination with Dew ('969), Anderson et al and Belkin et al as applied to claims 1-3, 6-8, 12-14 and 17-19 above, and further in view of Assa et al..

Assa et al teach a scanning handpiece and the equivalence of carbon dioxide and Erbium YAG lasers. Thus It would have been obvious to the artisan of ordinary skill to employ a handpiece as

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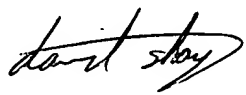
taught by Assa et al, since this allows more consistency of treatment and to employ an erbium laser, since these are equivalent to the carbon dioxide laser, thus producing a device such as claimed.

Applicant argues that Skar et al "is not considered by applicants to be analogous art".

This argument is not convincing for a variety of reasons. Applicant's attention is respectfully invited to page 1, line 6, of the instant disclosure wherein under FIELD OF THE INVENTION it is stated that: "The present invention relates to the field of medical lasers." The disclosure of Sklar et al Entitled "METHOD AND APPARATUS FOR PRECISION LASER SURGERY" is clearly in the <sup>field</sup> ~~filed~~ of medical lasers. Secondly Skar et al specifically discuss cutting at column 5, lines 60-65. <sup>Lastly</sup> ~~Lastly~~ applicants attention is respectfully invited to the information disclosure statement filed December 13, 1999, particularly to document AD Therein. The examiner respectfully submits that if Skar et al were non-analogous art, that it should not have <sup>been</sup> ~~been~~ submitted for consideration by the examiner. Thus these argument are not persuasive.

Applicant's arguments filed October 2, 2000 have been fully considered but they are not persuasive. Any inquiry concerning this communication should be directed to David Shay at telephone number (703) 308-2215.

David Shay:bhw  
February 28, 2001

  
DAVID M. SHAY  
PRIMARY EXAMINER  
GROUP 330